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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,887	06/08/2001	Anders Pettersson	103364603US	9973

466 7590 09/25/2002

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EXAMINER

YOUNG, MICAH PAUL

ART UNIT PAPER NUMBER

1615

DATE MAILED: 09/25/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/787,887

Applicant(s)

PETTERSSON ET AL.

Examiner

Micah-Paul Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 18 provides for the use of fentanyl or a pharmaceutically acceptable salt in micro-particle form, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 18 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### *Double Patenting*

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1- 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1- 21 of copending Application No. 09/787,888. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '888 Application claims could read as prior art over the current application.

6. Claims 1 – 17 of the current application are drawn to pharmaceutical composition for the sublingual treatment of acute pain, sublingual with fentanyl. The composition is an ordered mixture of micro-particles what is free of water. The composition comprises carrier particles, which are coated to the surface of smaller active agent particles. The carrier comprises disintegrants, surfactants and other commonly used in the art. The claims differ in that the compound is used for the treatment of acute pain instead of an acute disorder. Claims 19 and 20 are drawn to method of treating acute pain using the composition of the invention.

Claims 1 – 18 of the '888 application instant case are drawn to a pharmaceutical composition for the treatment of acute disorders, sublingually with fentanyl or an acceptable salt. The composition is an ordered mixture of micro-particles that is free of water. The composition comprises carrier particles, which are coated to the surface of smaller active agent particles. The carrier comprises disintegrants, surfactants and other commonly used excipients all well known

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in the art. Claims 19 – 21 are drawn to a method of treating an acute disorder using the composition of the invention.

Despite their differences one of ordinary skill in the art would be motivated to use the composition of current application to treat an acute disorder such as pain. The compositions of the two applications are identical. The compositions share the same active agent, the same carrier constituency, the same particle size and active agent dosage. It would have been obvious to a skilled artisan to use the composition of the present invention or that of the '888 application to deliver a therapeutic effect, and treat an acute disorder such as pain.

With regard to claims 18 which is a uses claim, though neither the '888 application does not claim the use of fentanyl, its use is implied by the virtue of the claims. As discussed above use claims are not patentable under United States statutes. The claim is also obviated by the current copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1- 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Nyström (EP 0 324 725) in view of knowledge in the art. Claims 1- 17 are drawn to pharmaceutical composition for the treatment of acute pain , sublingually. The composition is an ordered mixture of micro-particles that is free of water. The composition comprises carrier particles, which are coated to the surface of smaller active agent particles. The carrier comprises disintegrants, surfactants and other commonly used excipients all well known in the art. Claims 19 – 20 are drawn to a method of treating acute pain sublingually using the composition of the invention.

Nyström teaches essential elements of the claimed invention. The reference discloses an ordered mixture of drug particles in a carrier composition. The compound of the invention is water-free and includes comprises conventional pharmaceutical additives such as glidants, lubricants, surfactants, disintegrants, and other compounds well known in the art. The drug particles of the invention measure no larger than 10 microns, while the carrier particles measure between 100 and 500 microns. The active agent is selected from various analgesic or anesthetic compounds known in the art, yet the specific compound is only restricted by its solubility in water, the lower the better. The most important aspect of the invention is the fact that the

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compound remains water-free so that the active agents do not dissolve too quickly. Also Nyström teaches various delivery methods, including oral and topical. The delivery method and specific location is non-critical as long as the composition remains water free (col. 2, lin. 43 – col. 5, lin. 14; Examples).

Though the reference discloses many essential elements of the claimed invention, it is silent to particular active agent, the specific constituents of the carrier compound. The reference teaches that microcrystalline cellulose, polyvinylpyrrolidone and mannitol (Examples), but a specific surfactant is not named, though lubricants are suggested as additives. Nyström further differs in that it does not use the same active agent in its compound. The reference discloses various analgesic compounds that can be used, and stipulates that though these are not a complete list, any compound can be incorporated in to the composition depending upon its water solubility.

With regard to the active agent as claimed by applicant, fentanyl is well known in the art as an analgesic. As disclosed by Fine et al (Clinical Note, *Pain*, **45**, 1991, 149 – 153) oral transmucosal fentanyl citrate (OTFC) has been used in the art to deliver the analgesic sublingually. In the form of lollipops and lozenges, the OTFC has been delivered to patients suffering from acute breakthrough pain (Introduction).

With regard to the constituents of the present invention, specifically the carrier particles, these are also well known in the art. Nyström clearly names the bio/mucoadhesive (microcrystalline cellulose), the disintegrant (polyvinylpyrrolidone) and the carbohydrate (mannitol) of the current invention, yet only suggests the use of a surfactant. The reference suggests that other excipients known in the art be uses, such as lubricants, of which surfactants

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can be used. As seen in many of the Stanley patents for the sublingual administration of analgesics, specifically USPN 5,288,498, sodium lauryl sulfate is used as the surfactant to lubricate the composition, which delivers fentanyl (Abstract, Examples).

With regard to claims 19 – 20 which recite a method for treating acute pain using the composition of the invention. Though Nyström does not suggest the therapeutic effects of the composition, it is apparent that with the addition of analgesic or anesthetic compounds, the composition given its constituency and dissolution profile could be used to treat a range of disorders. Coupled with the knowledge in the art of OTFC, a skilled artisan would be able to use the invention of Nyström to deliver therapeutic agents to treat pain, acute or otherwise.

With regard to claims 2, 3, 7, 11, 17 and 20 which recite specific concentrations and dosages for the composition constituents, these limitations are held as non-critical and obviated by the prior art. Nyström provides the general combination of active agent particles with bio/mucoadhesive particles, along with suggestions to specific excipients. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454 105 USPQ 233, 235 (CCPA 1955).

Furthermore the claims differ from the reference by reciting various concentrations of the active ingredient(s). However, the preparation of various pharmaceutical compositions having various amounts of the active is within the level of skill of one having ordinary skill in the art at the time of the invention. It has also been held that the mere selection of proportions and ranges is not patentable absent a showing of criticality. *In re Russell*, 439 F.2d 1228, 169 USPQ 426 (CCPA 1971).



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With these aspects taken into consideration, one of ordinary skill in the art would have been motivated to combine the composition of Nyström along with its suggestions, with the knowledge in the art. A skilled practitioner would have been motivated by the suggestion of lubricants by Nyström, to combine the fentanyl and sodium lauryl sulfate of Stanley into the formulation of Nyström. A skilled artisan would have been aware of the therapeutic properties of OTFC, and been motivated to include it into the composition as well. One of ordinary skill in the art would have been motivated to combine the teachings of Stanley with those of Nyström in order to provide analgesic properties to the composition and to provide sufficient lubrication though the use of the sodium lauryl sulfate. A skilled artisan also would have followed the teachings of Fine to discover the sublingual and transmucosal properties of fentanyl. It would have been obvious to one of ordinary skill in the art, at the time of the invention to combine these teachings with an expected result of an ordered mixture that is essential free of water and capable of delivering fentanyl to a patient in need, relieving pain.

### *Conclusion*

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lewis et al (EP 0 144 243) discloses a composition for the sublingual delivery of analgesics comprising mannitol and other water-soluble excipients.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Micah-Paul Young whose telephone number is 703-308-7005. The examiner can normally be reached on M-F 7:30am-4: 30pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7648 for regular communications and 703-746-7648 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Micah-Paul Young  
Examiner  
Art Unit 1615

MPY  
September 20, 2002

  
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